

REMARKS/ARGUMENTS

Status of the Claims

Claims 1, 6, and 8 are currently amended.

Claims 9 and 36 are canceled.

Claims 4, 7, and 17-35 were previously canceled.

Claims 2, 3, and 10-16 are in their original form.

Claims 37-58 are new.

Claims 1-3, 5-6, 8, 10-16, and 37-58 are currently pending in this application.

Rejections under 35 USC § 102(b)

Claims 1, 2, 8, and 10-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Chatterji et al. (U.S. Patent No. 5,688,844) (hereinafter “*Chatterji*”). Claims 1, 2, 6, 8, 10-12, and 13-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Griffith et al. (U.S. Patent No. 6,448,206) (hereinafter “*Griffith*”). As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants have amended claim 1 to overcome the anticipatory rejections of *Chatterji* and *Griffith*. Claim 1 has been amended to read:

1. A method of servicing a wellbore in contact with a subterranean formation, comprising: displacing a sealant composition comprising a colloiddally stabilized latex into the wellbore, **wherein the colloiddally stabilized latex remains substantially stable in a solution of at least 25 weight percent salt without additional stabilizers.**

See claim 1, *supra* (emphasis added).

Support for the current amendment is found in the specification. *See, e.g.*, Application at ¶ [0028] (“LATEX 2000 latex sold by Halliburton Energy Services, Inc. (i.e., a styrene butadiene latex prepared by conventional methods) was added dropwise to an aqueous solution containing 25 weight (wt.) % sodium chloride (NaCl) salt. Instantaneous precipitation was observed upon contact of the latex with the salt solution. The same procedure was then performed using 10 mL of BS 2100 latex, i.e., a colloiddally stabilized latex. No precipitation was observed in the solution containing the BS 2100 latex even after several days.”); and ¶ [0020] (“The colloiddally stabilized latex has a relatively high tolerance to salts. Thus, it desirably remains stable in the presence of the salts contained in the sealant compositions and in the presence of salts that it may encounter in the wellbore without the need to introduce additional stabilizing surfactants, e.g., ethoxylated nonylphenol surfactant, to the sealant compositions.”). Thus, the Application specifically discloses that its colloiddally stabilized latex remains substantially stable in a solution of at least 25 weight percent salt without additional stabilizers.

Neither *Chatterji* nor *Griffith* disclose a colloiddally stabilized latex that remains substantially stable in a solution of at least 25 weight percent salt without additional stabilizers. Both *Chatterji* and *Griffith* disclose that LATEX 2000 latex is in accordance with their teachings. *See, e.g.*, *Chatterji* at col. 5, lines 5-8 (“A latex of this type is available from Halliburton Energy Services of Duncan, Okla. Under the trade designation ‘LATEX 2000™.’”); and *Griffith* at col. 4, lines 54-56 (“A latex of this type is available from Halliburton Energy Services of Duncan, Okla. Under the trade designation ‘LATEX 2000™.’”).

As disclosed in the instant Application, LATEX 2000 latex does not remain stable in a solution of at least 25 weight percent salt. *See* Application at ¶ [0028] (“LATEX 2000 latex sold by Halliburton Energy Services, Inc. (i.e., a styrene butadiene latex prepared by conventional

methods) was added dropwise to an aqueous solution containing 25 weight (wt.) % sodium chloride (NaCl) salt. **Instantaneous precipitation was observed upon contact of the latex with the salt solution.** (emphasis added).

Based on the foregoing, independent claim 1 should be allowed as it is not anticipated by *Chatterji* or *Griffith*. Additionally, because dependent claims 2, 3, 5, 6, 8, 10-16, and 37 depend on claim 1, dependant claims 2, 3, 5, 6, 8, 10-16, and 37 should be allowed because they are not anticipated by *Chaterji* or *Griffith*.

Rejections under 35 USC § 103(a)

Claims 3, 5, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chatterji* in view of Krishanan (U.S. 5,900,451) (“*Krishanan*”). Similarly, claims 3, 5, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Griffith* in view of *Krishanan*. Lastly, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chatterji* in view of *Griffith*.

The MPEP provides:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

See MPEP § 2143.

First of all, claims 3, 5, 6, 8, and 12 all depend from claim 1. As explained in reference to the section 102 rejections above, neither *Chatterji* nor *Griffith* disclose “a collodially stabilized latex that remains substantially stable in a solution of at least 25 weight percent salt without additional stabilizers.” Thus, claim 6 is allowable over the combination of *Chatterji* and *Griffith*. Further, the Office Action does not cite *Krishanan* to teach the limitations that are absent from *Chatterji* and *Griffith*. Thus, the Office Action does not establish a *prima facie* case

of obviousness as to claims 3, 5, 8, and 12, which are allowable over the cited prior art, because the Office Action does not “clearly articulate” nor “explicitly support” how *Krishanan* discloses “a collodially stabilized latex that remains substantially stable in a solution of at least 25 weight percent salt without additional stabilizers.”

Applicants further contend that the combination *Chatterji*, *Griffith*, and *Krishanan* cannot render the instant claims obvious. As acknowledged by the Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741-42 (2007).

Accordingly, the Supreme Court went on to explain that in making an obvious determination under 35 U.S.C. § 103(a), “when a patent claims a structure already known in the prior art . . . the combination must do more than yield a predictable result.” *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741-42 (2007). To that end, when a patent “‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *See id.* (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273 (1976)). As is evident from the Supreme Court’s holding in *KSR Int’l Co. v. Teleflex, Inc.*, “obviousness” is a function of “predictability” and “predictability” flows from “known elements” performing “known functions.” *See id.*

Based on the Supreme Court’s holding in *KSR Int’l Co. v. Teleflex, Inc.*, a combination of “known elements” would not be obvious when the result of the combination is not predictable -- the result of the combination would not be predictable when “known elements” in the combination do not perform “known functions.” *See id.* This supposition is supported by the Court of Appeals for the Federal Circuit’s holding that unexpected properties of an invention

render the invention nonobvious. See *Aventis Pharma Deutschland GmbH v. Lupin, Ltd.*, 84 USPQ2d 1197 (Fed. Cir. 2007).

A *prima facie* case of unpatentability cannot be established via the combination *Chatterji*, *Griffith*, and *Krishanan* because stability “in a solution of at least 25 weight percent salt without additional stabilizers” is not a “known function” of any of the latexes disclosed in the cited prior art. None of the cited prior art teaches this limitation of claim 1.¹

New Claims

New claim 37 further recites a specific surfactant and is supported at paragraph 0014. New claim 38 mirrors claim 3. New claims 39-46 mirror claim 11. New claims 47-55 mirror claim 10. New claims 53, 54, and 55 are supported in paragraphs 0024 and 0026. These new claims directly or indirectly depend from claim 1 and are therefore allowable for the reasons discussed previously.

¹ Any reliance on an inherency-type argument as the basis for an obviousness rejection of the instant claims would be futile. An inherent function may or may not be a “known function.” If the inherent function is not a “known function,” the inherent function cannot support a determination of obviousness -- anticipation perhaps, but not obviousness.

CONCLUSION

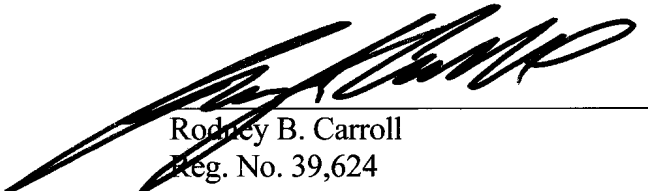
Consideration of the foregoing and reconsideration of the application, and withdrawal of the rejections are respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated March 5, 2008 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: _____

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